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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/401,659 09/23/99 OGINO

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EXAMINER
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005514 IM52/0227  
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SCHWARTZ, P	
ART UNIT	PAPER NUMBER

1774  
DATE MAILED:

02/27/01

8

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademark**

# Office Action Summary

Application No.

09/401659

Applicant(s)

Ogino et al.

Examiner

Schwartz, P

Group Art Unit

1774

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-8 is/are pending in the application.  
Of the above claim(s) 6-8 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-5 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-8 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 6 and 7
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to a recording medium, classified in class 428, subclass 195.
  - II. Claim 6, drawn to a process of producing a recording medium, classified in class 427, subclass 146.
  - III. Claim 7-8, drawn to a process of using, classified in class 347, subclass 105.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and of Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as by applying to a substrate an aqueous adhesive composition and then sprinkling the adhesive composition with alumina hydrate followed by drying.

3. Inventions of Group I and of Group III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as a process of writing with an ink pen.

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4. Inventions of Group II and of Group III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions.
5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
6. During a telephone conversation with Ms. Dudek on February 21, 2001 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
8. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 3, the phrase, "a maximum peak" is unclear because it would lead one to

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believe that there may be other maximum peaks. It is also confusing because if there are other maximum peaks, it raises the question: is the one the true maximum or not? In order to correct this, "a" should be changed to --the-- before "maximum".

9. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshino et al and Eguchi et al. (EP 709,222 and EP 701,904 respectively).

Each of the references discloses a recording medium having a substrate and an ink receiving layer of alumina hydrate of boehmite structure on the surface thereof. Yoshino et al. disclose the criticality of the crystallite size in a particular direction (the Abstract) and Eguchi et al. disclose the degree of parallelization (page 4, page 7 and the examples), the particle size and shape, and the pore volume (page 5, lines 7-15). Eguchi et al. do not specifically discuss the particle thickness but do so inherently by disclosing the particle shape and the maximum particle length or diameter. In addition, the references disclose methods of making the alumina hydrate and recording medium which are the same or similar to those instantly disclosed and state that processing conditions are used to control the properties of the alumina hydrate (for example, see Table 1 on page 9 of Eguchi et al. which lists some of the processing conditions and the properties that result).

Since the properties that applicants' desire to achieve have been identified in the prior art, as well as the methods of achieving variations in these properties, it would have been obvious to one of ordinary skill in the art to utilize these disclosures to form an alumina hydrate and recording medium having properties resulting desired printing results. The experimental

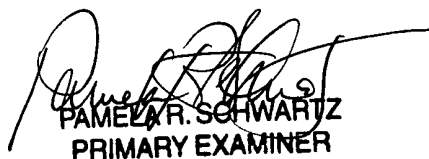
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modification of the prior art in order to ascertain optimum operating conditions (for example, determination of crystallite size in the direction of the (020) plane or particle thickness) fails to render applicants' claims patentable in the absence of unexpected results. In re Aller, 105 USPQ 233.

10. Claims 1,4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshino et al and Eguchi et al. (EP 709,222 and EP 701,904 respectively) as applied to claim 1 above, and further in view of Misuda et al. (5,104,730) or applicants' admissions on page 4 of the specification.

Misuda et al teach that it is known to utilize a layer of silica powder over a layer of pseudoboehmite in a recording sheet in order to avoid the problem of hindered color development (col. 4, lines 47-61). On page 4 of their specification, applicants admit that use of such a silica layer is also known in the art to reduce scratch marking. Based upon these teachings, it would have been obvious to one of ordinary skill in the art to cover the alumina hydrate layer of the primary references with a silica layer to achieve one or more of the desired benefits taught by the secondary art.

PRSchwartz  
February 26, 2001

  
PAMELA R. SCHWARTZ  
PRIMARY EXAMINER